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EXAMINER

HOOK, JAMES F

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 14

Application Number: 09/312,992  
Filing Date: May 17, 1999  
Appellant(s): Scott E. Johnston

\_\_\_\_\_  
Scott E. Johnston, Pro Se  
Appellant

MAILED  
DEC 17 2001  
GROUP 3700

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed October 12, 2001.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1, 5, and 9 should be considered separately which is considered equivalent to saying that these claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8), however, the remaining claims 2-4 and 6-8 are considered to stand or fall based upon the merits of claims 1 and 5 respectively.

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**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,852,616	HOLCOMB	8-1989
"Handbook of Steel Drainage & Highway Construction Products." American		
Iron and Steel Institute, 1983, pp. 6-65.		

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

A. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by the Handbook of Steel Drainage. The reference to the Handbook of Steel Drainage discloses the recited spiral formed pipe comprising an elongated strip formed of ductile material such as sheet metal formed into adjacent helical convolutions, with a corrugated wall portion, seams which can be either lock seams or welded, where the dimensional proportions are increased along with pipe size, and where it is noted that conventional pipes of this type are capable of ranging in diameters from 6 inches to 21 feet in diameter, and can be formed into arch shapes of large diameters too as seen on page number 38.

B. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Holcomb. The patent to Holcomb discloses the recited

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spiral formed pipe comprising an elongated strip formed of ductile material such as sheet metal formed into adjacent helical convolutions, with a corrugated wall portion 26, seams which can be either lock seams or welded, where the dimensional proportions are increased along with pipe size, and where it is taught that conventional pipes of this type are capable of ranging in diameters from 6 inches to 21 feet in diameter and it is implied that the pipe in Holcomb is made following these standards, and therefore it is believed that the pipe of Holcomb can also be made up to those dimensions if such were needed, where the dimensions are not considered limited by the examples tested in Holcomb.

C. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb in view of the Handbook of Steel Drainage. The patent to Holcomb discloses all of the recited structure with the exception of reshaping the tube as an arch. The reference to Handbook of Steel Drainage discloses the recited convoluted pipe formed of a ductile metal material can be made from tubes having large diameters which are either rounded in shape or can be formed in arch shapes, that such can be formed of the same types of pipes including seam welded and lock seamed pipes. It would have been obvious to one skilled in the art to modify the shape of the pipe in Holcomb to be reshaped into an arch shape to provide a different profile which can be stronger as suggested by Handbook of Steel Drainage.

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**(11) *Response to Argument***

To simplify the examiners position on appellant's arguments, the examiner will reference the numbering system used by appellant in his appeal brief. With respect to the arguments set forth in section 1, the chart on page 38 of The Handbook of Steel Drainage (from now on referred to as the Handbook reference) has as its heading "Shapes and Uses of Corrugated Conduits" and provides examples of ranges of sizes of corrugated conduits. On page 40, under the heading Description of Corrugations, the Handbook sets forth the various types of conduits considered as corrugated conduits which includes various types including structural plate and lock seam pipes. It is hereby concluded by the examiner that the prior art Handbook reference clearly sets forth the manner in which corrugated conduits can be formed, including lock seamed, and clearly sets forth in the table that such corrugated conduits, which the examiner considers to be conventional as taught by the prior art Handbook reference on page 40, can include round conduits up to 21 feet in diameter, and also sets forth 6 in diameters. It can clearly be seen in the common uses that plates are mentioned, however, based on the disclosure on page 40 of the Handbook reference, plates are merely one manner in which to form corrugated conduits. It can also be argued that the teachings of the table suggest a 6 inch diameter pipe. If the table intended to merely disclose corrugated pipes made by the plate method, as appellant suggests by the appearance of the word "plate" in the common uses section of the table, then such is a clear mistake in reading the reference, since the reference clearly sets forth on page 60 that plate manufactured pipes have minimum

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diameters ranging in sizes from 5 feet 8 inches up to larger sizes. It is considered by the examiner that a pipe having a 6 inch diameter would not be made by a plate method, and therefore the table on page 38 of the Handbook is not reciting dimensions of only plate manufactured pipes but rather corrugated pipes in general as suggested by its title, and that the reference clearly states on page 40 that a lock seam pipe is another embodiment used to make pipes of this type. It should be noted by the Board of Appeals that the disclosure on page 40 of the Handbook sets forth merely desired corrugation sizes based upon pipe diameter, but should not be limiting to pipes made by the lock seam method with respect to diameter, the recitation on page 40 is merely a recommended corrugation size for a certain diameter of pipe, not a limitation on the diameter the pipe can be made with. Further, on page 46 of the Handbook, it is set forth that "standard methods of shop-fabricating the seams of annularly corrugated steel pipe and pipe arches are riveting or resistance spot welding; for helically corrugated, a lock seam or continuous welding" which clearly sets forth that the reference when referring to corrugated steel pipe formed in round or arched shapes, is referring in kind to all types including lock seam.

With respect to argument 2 of appellants brief, page 40 and 46 of the Handbook, as referenced above, it is clearly set forth that the term "corrugated conduit" in the title of the table of page 38, refers to all types of corrugated tubing including those made by the method of lock seam, and it is believed that since the reference is a prior art reference teaching what is known in the art at the time the reference was created, that such sets forth what is conventional

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in the art, and the table on page 38 teaches that round corrugated pipes can have diameters up to 21 feet. Therefore, the Handbook reference clearly sets this recitation forth. It further states on page 8, under the heading "SIZES AND SHAPES" that "Steel conduits are available for many applications, in a wide range of sizes and shapes-round pipe in diameters of 6 inches to 24 feet and more, elliptical pipe, pipe-arches, horseshoes, arches and other shapes" thereby also clearly stating that the known conduits at the time the reference was created, could span diameters even as high as 24 feet and higher, where the reference later goes on to set forth what methods the seams of the pipe can be made, including lock seam.

With respect to appellants argument 3, the examiner has stated above where the Handbook reference sets forth the definition of the terminology of "steel conduits" and "corrugated conduits". It is clearly set forth in the reference and nothing further can be said at this time that wasn't set forth above in regards to this argument. With respect to the dimensions of the arched conduit, table 38 of the Handbook sets forth that arched conduits can have a span as large as 20 ft. 7 in. The terminology is consistent throughout the Handbook reference using the terms corrugated conduits, and pages 40 and 46, as mentioned above, clearly set forth the manner in which the seams of the pipe can be formed including lock seams.

With respect to argument 4, there is no argument set forth which pertains to the inadequacies of the 102(b) rejection, therefore such is not being addressed here, but it is also



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noted that a condition of hindsight is not considered pertinent to an argument directed toward anticipation of a reference.

With respect to argument 5, it is noted that appellant acknowledges that "Generally it's true, and well supported that merely following in the steps of prior teachings and increasing or decreasing the size of an article is not the result of invention", and proceeds to cite a CCPA decision. There is no other argument set forth with respect to this statement being false, and therefore it is believed that the appellant agrees with it. In light of the claim language, there is no limitations set forth that are specific to a specific structure of the lock seam that differs from the prior art and therefore appellants claimed lock seam conduit is considered the same as the prior art lock seam. It in no way affects the expected result of obtaining a large diameter conduit, and making such in a larger dimension with no structural difference from the prior art, suggests that such is merely a change in dimension only. However, such an argument appears in the discussion of the rejection under 102(b) with respect to the Handbook reference, and such an argument to the relevancy of a size change is immaterial when discussing the anticipation of the claims by the Handbook reference. The same is true of the recitation of the Edison material which has no bearing on the anticipation of the claims by the Handbook reference in light of the fact there is no specific argument set forth that is relevant to the rejection.

With respect to argument 6, there likewise is no relevant argument made toward the inadequacies of the rejection under 102(b) under the Handbook reference therefore such is

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moot. However, in light of the claim language, and the fact that there is no method claimed, such is also a moot point.

With respect to argument 7, appellant had set forth many arguments in the response filed on January 2, 2001, one of which was directed toward the manner in which the prior art pipe would reach the site where it was to be used, and the examiner merely stated that such would hold no patentable weight when such would not change the structure of the lock seam being claimed, and further that such is a moot point when the language of the claims would not support such an argument. It is also noted that this in no way has any bearing on the argument of anticipation of the claims under the Handbook reference.

With respect to argument 8, the examiner did not miss the fact that the above argument of how the pipe was transported to the site was an attempt at setting forth unexpected results, such was a moot point in that such was not supported by the claim language, and likewise would not set forth unexpected results when an issue of unexpected results would be obtaining a result not expected. One skilled in the art creating a lock seam pipe of a diameter larger than 15 feet would expect the result of obtaining a lock seam pipe of a diameter larger than 15 feet, there is no ambiguity as to what one skilled in the art would expect and that such could not create a situation of unexpected results, however, such is still a moot point when such is not a limitation of the claims, and therefore not under review by the Board of Appeals with respect to the anticipation of the claims under the Handbook reference. The examiner did address this argument in the final rejection mailed March 27, 2001 in the explanation of such not being

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required by the claim language in that such encompassed the entire argument based upon this fact when there was no unexpected result present.

With respect to argument 9, the statement by the examiner is supported by the Handbook reference as set forth above in regards to the teachings of the various embodiments that the seam can take, including lock seam, and the teachings of the table on page 38. There is no combination of embodiments made by the examiner, the examiner is taking the teachings of the reference alone, and there is nothing that suggests that the table on page 38 is limited only to steel plate pipes as the examiner sets forth above and will not be repeated at this time.

Argument 10, does not set forth an argument against the rejection under 102(b) with respect to the Handbook reference but merely recites what is found in the MPEP under rules of practice and does not set forth any argument, and such is moot when referring to the Handbook rejection under 102(b) when such relates to issues under 103, however the portion that does relate to 102(b), the examiner has stated above that the Handbook reference discloses appellants claimed lock seam pipe in an anticipatory manner.

With respect to argument 11, inherency is argued, however such is not a persuasive argument when the examiner has not made any suggestion in the final rejection of the claims under 102(b) with respect to the Handbook reference that inherency was relied upon, therefore such is a moot argument. The examiner holds the position that the Handbook reference recites all of the claimed structure. With respect to the recitation of the Cimiotti Unhairing Co.

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decision, such is not considered an adequate argument with no suggestion as to why this case is pertinent with respect to the rejection under 102(b) with respect to the Handbook reference.

With respect to argument 12, such is directed solely to the argument that the Handbook reference does not teach forming the pipe on the job site or how to get a pipe of larger diameter to the job site. Such is not a valid argument when such is not based upon the claimed apparatus under appeal. Therefore, there should be no further discussion needed with respect to this argument. Clearly stated, without such being in the claim language, such is not required to be met by the reference to meet the requirements of 102(b). Further, the argument under heading 12 continues with a discussion of USC 119, however such is also immaterial when the examiner did not use an issue of inherency when making the rejection under 102(b) with respect to the Handbook reference. Therefore, the examiner is not required to present theory with respect to this issue. Still under heading 12, is a discussion of D. Del. 1990, but such fails to provide any argument with respect to why this is pertinent to the rejection at hand, or of what pertinence it has at all in the appeal, such seems to be an attempt to include everything possibly ever decided in relation to Patent practice, but with no argument provided as to its pertinence to this application and appeal, such is not a pertinent but merely a statement of known patent procedure in the absence of any further explanation. The same is true of the discussion of D. Del. 1989.

With respect to argument 13, such states fact of what is found in appellants application with respect to intended use of the article but fails to disclose a rational argument as to why

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this has any bearing on the issue of a rejection under 102(b) with respect to the Handbook reference. Without any clear argument set forth under section 13 of appellants brief, where the only argument the examiner can possibly extract from the paragraph beginning with CI.Ct. 1986, is that appellant feels that by stating various uses in his specification he is in fact limiting the claimed article, such is not persuasive due to the lack of any discussion as to why unclaimed use of the article would make the rejection under 102(b) with respect to the Handbook reference improper. There, likewise, is no argument set forth with the recitation of the court case set forth in the paragraph beginning N.D. Ill. 1986, therefore such is not a pertinent argument when there is no actual discussion of why this case is pertinent with respect to the appealed claims, or any rejection made by the examiner. Simply stating known court decisions is not adequate enough to present a case against the examiner's rejection, because an explanation of pertinence is also required.

With regards to issue 2, and argument 14, column 1, lines 56-64 appear in the patent to Holcomb and state specifically "Spirally wound steel pipe is widely used for culverts, storm sewers, subdrains, spillways, underpasses and service tunnels. According to the Handbook of Steel Drainage and Highway Construction Products, published by American Iron and Steel Institute (Second Edition, 1971), round or circular corrugated steel conduits are in common use for such purposes for medium and high fills, or trenches, and range in diameter from six inches to 21 feet." Clearly the reference to Holcomb recites what is old and known in the art as taught by the Handbook reference, and clearly sets forth in the actual background of

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Holcomb that pipes up to 21 feet in diameter are known. The reference to Holcomb then continues to describe the teachings of the Handbook reference, which is the same Handbook reference used in the rejection above, in column 2, lines 2-4, that "there is also noted lock seam pipes, with the seams and corrugations running helically (or spirally) around the pipe." Therefore, the reference to Holcomb sets forth that lock seam pipes are known in the art as set forth by the Handbook reference, and that such pipes can have a diameter up to 21 feet. Therefore, it is held by the examiner that if one takes the teaching as a whole of the reference to Holcomb, including what is old and known in the art as set forth in the background of the invention in Holcomb, and further describes the teachings of the Handbook reference, then the language of claims 1-4 is anticipated by the disclosure of the Holcomb patent. With respect to the term "testing" used by the examiner in the final rejection, paper 8, the examiner was referring to Tables A and B in Holcomb where it was the examiners belief that Holcomb would not simply supply random numbers in a table but that any information set forth in such a manner would suggest some sort of testing, and therefore, the word "testing" may not appear in the reference but such is implied by the manner in which it was provided. However, it should be noted that this in no way affects the rejection under 102(b) or in the alternative 103 with respect to Holcomb, since such a statement was made in an attempt to explain to the applicant and appellant, that even though Holcomb sets forth a table which represents a sampling of helical angles used with a certain diameter pipe is in no way limiting to the overall dimensions the pipe of Holcombs patent could take, but that such is a mere table that would

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represent a tested sampling only, and is in no way suggestive that the pipe diameter be limited in any way, when such is directed solely to angles with respect to the certain diameters and not an all inclusive statement, especially in light of the background of the invention which sets forth via the teachings of the Handbook reference that lock seam pipes of similar design to Holcombs claimed article can have diameters up to 21 feet. Therefore, such is the basis for the examiners use of the term "tested" which is in no way a "broad, groundless statement" but a mere attempt to simplify the terminology and not further confuse the argument at hand, that being that the tables set forth in Holcomb are not limiting to the overall possible diameter of pipe that could be achieved with the teachings of Holcomb, including the teachings in Holcomb's Background of the Invention.

Argument 15, also addresses further argument on the point of the use of the word "tested" by the examiner, however, the explanation set forth in the discussion of argument 14 above is sufficient to set forth what the examiner was attempting to explain. Such was obviously not a matter of hindsight reasoning but mere interpretation of the reference to Holcomb as set forth above.

With respect to argument 16, Holcomb merely states that the teachings of the Handbook can be improved upon using the teaching of the Holcomb reference to reduce material needed directly relating to the corrugations and thicknesses used, but never discloses that Holcomb is in any way deviating from the standards set forth in the Handbook with respect to pipe diameters, and therefore such is not a persuasive argument, when such would in

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no way affect the overall teachings of the Handbook of known pipe diameters. The argument then continues to discuss the teachings of page 40, but in no way explains what this means, or why it in any way affects the teaching of Holcomb or those in the Handbook. Especially when the recitation on page 40 of the Handbook is only describing desired corrugations for larger pipes, and not that such is a limitation to the overall dimensions the pipe can be made from with a lock seam as set forth above by the examiner. The appellant is narrowing the focus of the Handbook reference and discounting its recitation that pipes are known in the art of lock seams that exceeds 96 inches (page 39, second paragraph, third line) and further recitation on page 38 of the Handbook reference that corrugated steel pipes can be made in round shapes up to 21 feet in diameter. However, this is moot when discussing the teachings of Holcomb, when Holcomb clearly restates the content of the Handbook reference in column 1, lines 56-64, when it sets forth that pipes can "range in diameter from six inches to 21 feet."

With respect to argument 17, Holcomb, as stated above numerous times, sets forth in column 1 what is known in the art as taught by the Handbook reference. Such clearly recited what is old and known in the art. Since such is contained in the Holcomb reference, then such is considered to meet the requirements of anticipation. There is nothing conflicting in the teachings of the Holcomb reference, when such clearly sets forth what is old and known in the art, specifically pipes up to 21 feet in diameter being made with lock seams, and there is nothing conflicting about its teachings even if it recites a table that sets forth merely what may have been tested, but is not all encompassing of the possible sizes the pipe of Holcomb could



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be formed in, in that the tables merely set forth desired angles of corrugations for pipes of different diameters but does not limit what is known in the art, but merely is a sampling of desired angles of corrugations used with specific diameters.

With respect to argument 18, once again appellant returns to the argument that the reference fails to teach how the pipe can be produced on the job site or how to convey the pipe to the job site, however, such an argument is more detailed than the language of the claim and therefore a moot point when such cannot be argued against the reference when such is not a limitation that the Holcomb reference is required to meet, either in an anticipatory manner or with respect to obviousness. The recitation of USC 119 is immaterial when referring to Holcomb in that such is a patent and not a "prior art printed publication" when such is referring to the difference between the teachings of a non patent reference with respect to a patent. Such is not the case when the patent to Holcomb recites the disclosed pipe diameter in the background of the invention, in column 1. Also, there is no inherency argument made by the examiner in his rejection under Holcomb with respect to 102(b), therefore such is a moot argument, even though no such argument accompanies the discussion of the General Electric case recited. There is no argument provided with the recitation of D.Del 1989, therefore such is considered moot. Without any clear argument set forth under section 18 of appellants brief, where the only argument the examiner can possibly extract from the paragraph beginning with Cl.Ct. 1986, is that appellant feels that by stating various uses in his specification he is in fact limiting the claimed article, such is not persuasive due to the lack of any discussion as to why

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unclaimed use of the article would make the rejection under 102(b) with respect to the Holcomb reference improper. There, likewise, is no argument set forth with the recitation of the court case set forth in the paragraph beginning N.D. Ill. 1986, therefore such is not a pertinent argument when there is no actual discussion of why this case is pertinent with respect to the appealed claims, or any rejection made by the examiner. Simply stating known court decisions is not adequate enough to present a case against the examiner's rejection, but an explanation of pertinence is also required.

With respect to argument 19, the first three paragraphs do not set forth any argument and therefor will not be discussed. With respect to the fourth paragraph, one skilled in the art would not find any part of acquiring a spirally formed lock seam pipe that had a diameter larger than 15 feet to be anything other than a predictable outcome, one skilled in the art could use the teachings of Holcomb including the background of the invention which sets forth what is known in the art to know that a lock seam pipe having a diameter up to 21 feet is possible based on the teachings of what is known in the art as set forth in Holcomb. Since the rejection under 103 is made in combination with a 102(b) rejection, it is considered by the examiner to be possibly in question as to whether one would consider the reference in Holcomb to be reciting the diameter of 21 feet in an anticipatory manner or whether one skilled in the art would have to use the teachings of the reference in such a way as to arrive at an obvious modification of that taught in Holcomb, there is really no hindsight applicable when all of the language used by the examiner is taken directly from the reference to Holcomb. Therefore,

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the examiner finds no basis to this argument, and cannot address it further than to state that the teachings of the patent to Holcomb are clear in what is known in the art, which includes lock seam pipes of diameters up to 21 feet as set forth in column 1 of Holcomb. The question of desirability is not being addressed in that such is merely assumptions made by the applicant. The examiner is treating the appealed claims based upon the teachings of Holcomb as directly recited in the patent and applying them to claimed structure only.

With respect to argument 20, it is considered in view of the teachings of Holcomb that one skilled in the art based upon the teaching of Holcomb on what is known prior art, specifically the Handbook reference, that pipes can be formed with lock seams and formed with diameters up to 21 feet. The desirability of doing so would be that one skilled in the art would find it obvious to vary the diameter of the pipe to meet his needs and that such does not require more than routine skill in the art to form a pipe of larger diameter, especially when the patent to Holcomb teaches that such is old and known in the art to do. Therefore the teachings are taken directly from the prior art, and are not based upon applicants disclosure in any way, therefore the In re Vaeck case recited by appellant is not applicable in this application, and should not hold weight in the appeal decision. Any argument with respect to the manner in which the pipe is transported or where it is made is moot when such is never claimed. Simply put, appellant is claiming a pipe having a helical lock seam with a diameter greater than 15 feet, nothing more, therefore, such a pipe could be made anywhere by anyone skilled in the art using the teachings of Holcomb which sets forth it is known in the art to form

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lock seam pipes with diameters up to 21 feet. Any other argument with respect to unclaimed structure has no bearing on the appealed claims. The motivation to modify the Holcomb reference is clear, if one needs a pipe of larger diameter for use in large spillways, or other applications utilizing large pipe diameters, one would be able to utilize the teachings of Holcomb to know that such is possible in the art. Appellant continues to set forth various other cases which are not provided with any argument as to their pertinence to this application and the appealed claims, and therefore, with no argument set forth, these court cases have no weight on the current appealed claims and their rejection.

With respect to Issue 3, starting with argument 21, the appellant states with regards to the teachings of the Handbook reference and the making of arched conduits, "this teaching is not found in The Handbook of Steel Drainage", however, the Board of Appeals and appellant are directed to pages 38 and 39 which states in table 1-1 that pipes can be made in arch shapes, and further on page 39 under Section A "Conduits: Pipe, Pipe-Arches, Arches", in the Shapes of Conduits section, the Handbook reference states "Size and service use may control the shape selected, with strength and economy as additional factors" and therefore clearly sets forth that arched shapes can be used if desired when strength and economy are considered in corrugated pipe use. Therefore, such is not a "baseless, groundless, statement" but a direct quote from the reference itself. The section quoted above from page 39 of the Handbook provides the necessary motivation to make a pipe into an arched shape, and the reference to Holcomb directly quotes the teachings of the Handbook reference in columns 1 and 2, where it

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mentions the various tables set forth in the Handbook reference and its teachings of making pipes into arc shapes, based upon needs, thereby providing the motivation to combine the references. Therefore the examiner has set forth a clear case of prima facie obviousness. It should be noted that appellants attempt to draw in the basis of the rejection based upon the "inventions value" is in no way pertinent to a rejection under 103 with respect to the combination of references, or the rejection of the appealed claims, and therefore is not a pertinent argument.

With respect to argument 22, the motivation to combine the references was set forth above, the reasonable expectation of success would come from the fact that one skilled in the art from the teachings of Holcomb and the Handbook reference would see that when strength and other situational needs arise, an arched pipe having a large diameter, including larger than 144 inches, is known in the art and that one would have a reasonable expectation that such could be accomplished base upon the teachings of the Holcomb reference in view of the Handbook reference and what it teaches is known in the art. Once again, the argument also arises as to the manner in which the pipe could be transported or created on site, however, such is not recited in the appealed claims 5-9, and therefore a moot argument when only claimed subject matter can be considered as applicable limitations. Since the claims do not set forth where the pipe is manufactured or transported such cannot be argued when according to the broad nature of appellants claim language his pipe could be formed anywhere. Appellant even acknowledges on page 24, lines 9 and 10 of their appeal brief, that a forty foot diameter

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pipe could be created in a factory, which suggests that appellant realizes that such is possible for one skilled in the art, and based upon the broad claim language being appealed, the pipe could be manufactured in a factory and left there. As mentioned above, the motivation to combine the references is clearly set forth by the references themselves, as well as the desirability of making the modification, and it is clear one skilled in the art could expect reasonable success at doing so based upon the teachings of the Holcomb and Handbook references. Once again, court cases are recited in the last lines of page 24 of appellant's brief which have no arguments of pertinence with respect to the rejection under 103 of claims 5-9 under Holcomb in view of the Handbook reference, and therefore, such are not legitimate arguments but merely stating court cases with no reasons why they are applicable.

With respect to appellants conclusionary remarks, specifically beginning with paragraph 2 of page 26 of the appeal brief, such is not an appealable subject which can be reviewed by the Board of Appeals, when such is not a current rejection under final rejection. Likewise, the Board of Appeals cannot affect amendments to claims or removal of previous amendments to claims. For appellants benefit though, it is pointed out that the rejection under 112 was made based upon a range within a range, and was in no means directed toward the use of the term "whereby". However, such is not an appealable issue to be considered by the Board of Appeals and will not be mentioned further.

In conclusion, the examiner has set forth the recitations and teachings of the references set forth above, including motivation to combine which can be found in the references

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themselves, including motivation to make the changes which also is found in the references, and that reasonable success could be expected. Appellant has set forth many decisions on Appeal and other court cases but rarely ever gives an argument as to the pertinence of citing the cases or how they apply to the instant application under appeal. Appellant also sets forth arguments which are not based upon the claim language under appeal, and therefore such should hold no weight on the decision of the Board of Appeals. It is clear what the references disclose, there is no ambiguity or confusion by the statement that pipes in the art formed with lock seams and with helical corrugations were old and well known, and that such could be made with diameters up to 21 feet as set forth in the Handbook reference and reiterated in the Holcomb reference.

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For the above reasons, it is believed that the rejections should be sustained.

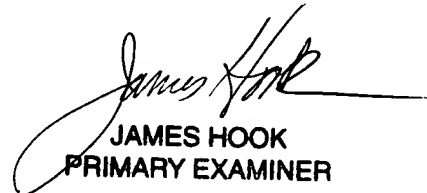
Respectfully submitted,

JFH  
December 17, 2001

Appeal Conference: Patrick Brinson



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